REMARKS

Claims 1-3, 5-6, 8, and 10-12 are pending after entry of this paper. Claims 1-3, 5-6, 8, and 10-12 have been rejected. Claims 4, 7, and 9 have been canceled without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in a divisional or continuing application.

Claims 1-3, 5-6, 8, and 10-12 have been amended to clarify the claimed invention by replacing the phrase "the transfer and insulation device" with the phrase "the device." This replacement clarifies the specific features of the claimed device having a transfer portion and an insulation portion.

Claim 1 has been amended to clarify the claimed device to be one single piece with the additional element that the insulation portion is attachable to an electrode. Support for Claim 1 may be found throughout the original specification, for example paragraph 1 on page 4.

Claims 5 and 6 have been amended to describe the elements that allow the device to be attachable to an electrode suspension rod. Support for Claims 5 and 6 may be found throughout the original specification, for example paragraph 1 on page 4 and page 6, lines 8-31 to page 7, lines 1-2.

Claim 8 has been amended to properly depend on Claim 1 and to clarify that the transfer portion of the claimed device is provided with a gripping lug. Support for Claim 1 may be found throughout the original specification, for example paragraph 2 on page 4.

No new matter has been introduced by these amendments. Reconsideration and withdrawal of the pending rejections in view of the above claim amendments and below remarks are respectfully requested.

Response to Rejections under 35 U.S.C. §112

Claims 1-3, 5-6, 8, and 10-12 have been rejected under 35 U.S.C. §112, second paragraph for indefiniteness. Specifically, the Examiner contends that these claims "are vague and indefinite with respect to how an electrode can be attached to a transfer and insulation device" and how the device can "still be one single piece, since the transfer and insulation device is being instantly claimed" (Office Action, pg. 2). Accordingly, the Examiner concludes that "the electrode would be given little or no patentable weight since the transfer and insulation device of single piece construction is what is being instantly claimed" (Office Action, pg. 2). Applicants respectfully disagree.

However, in order to expedite prosecution and solely for the purpose of allowance of the instant application, Applicants have amended Claims 1-3, 5-6, 8, and 10-12 to clarify the composition of the claimed device in order to better describe the transfer portion and the insulation portion of the device. Specifically, Claim 1 requires that the claimed device has a transfer portion and an insulation portion, which are made from one single piece, and *additionally* the insulation portion is attachable to an electrode.

The Examiner contends that a "transfer and insulation device of single piece construction is what is being instantly claimed" and therefore "the electrode [should] be given little or no patentable weight" (Office Action, pg. 2). Instead, Claim 1 states that the insulation portion of the single-piece device be attachable to an electrode as opposed to nothing or even some other object besides an electrode. Because the device of Claim 1 requires that the insulation portion be attachable to an electrode, the electrode should be given patentable weight since more than just a device of single piece construction is being instantly claimed.

Figure 1 of the instant application clearly illustrates one embodiment of the claimed device in which the insulation portion of the single-piece device is attached by means of a locking pin through the fastening point **14** to an electrode suspension rod **5** that passes through the device **1** (Page 6, paragraph 1 of the original specification). Additionally, the transfer portion may consist of both the grip lug **17** and the inclined part **18** on the grip lug (Page 6, paragraph 1 of the original specification).

In view of these arguments, Applicants respectfully request consideration and withdrawal of the rejection under 35 U.S.C. § 112 second paragraph for indefiniteness.

Response to Claim Objections

Applicants also respectfully disagree with the Examiner's objections to dependent Claims 4-12 under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner contends that these claims do not further limit the claimed device because they add extraneous features that are separate from the device (Office Action, page 3).

However, in order to expedite prosecution and solely for the purpose of allowance of the instant application, Applicants have amended Claims 5-6 and 8 to clarify their claimed subject matter. Applicants also respectfully assert that Claims 10-12 are in proper dependent form. Claim 5, as currently amended, is directed to a fastening point on the device "for fastening the insulation portion to the suspension rod of the electrode." Claim 6 is further directed to a device with an insulation portion that can at least partly enclose an electrode suspension rod when the device is fastened to the suspension rod (*see* Figure 2 and page 6, lines 24-31 to page 7, lines 1-2 of the original specification). Claims 8 and 10 are further directed to a transfer portion

"provided with a grip lug" where "the grip lug is provided with an inclined part" as opposed to some other type of transfer mechanism. Finally, Claims 11 and 12 simply add additional elements to the claimed device. Claim 11 adds a distribution element that does not affect the single-piece construction of the claimed device. (*see* Figures 1 and 2 of the original specification). Claim 12 simply requires that the insulation portion be specifically attached to an anode as opposed to a general electrode.

In view of these arguments, Applicants assert that Claims 5-6, 8, and 10-12 are in proper dependent form as they further limit the subject matter of the previous claims. Applicants respectfully request consideration and withdrawal of the 37 C.F.R. 1.75(c) objection to Claims 4-12.

Response to Rejections under 35 U.S.C. §102(b)

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kobayashi (U.S. Patent 6,193,863). According to the Examiner, Kobayashi anticipates Claim 1 because it allegedly discloses a one-piece supporting member made of a synthetic resin that is inserted around a cathode bar and is used to laterally transfer a ribbon like product into and out of an electroplating solution (Office Action, page 3-4).

Applicants respectfully disagree with the Examiner's conclusions regarding the teaching of Kobayashi. As described in column 5, lines 45-52 and as illustrated in Figure 6 of the Kobayashi specification the "aforementioned supporting member **10** made of synthetic resin is composed of a first supporting member **10A** . . . and a second supporting member **10B** . . . . The first supporting member **10A** and the second supporting member **10B** are *fixed by transfixing a clamping bolt* ***17***. . ." (emphasis added). Consequently, assuming *arguendo* that the

support member **10** is comprised of a transfer portion and an insulation portion (claim elements which the Examiner does not identify in the support member **10**), Kobayashi fails to anticipate Claim 1 of the instant application because the support member **10** consists of two separate pieces bolted together. The support member **10** of Kobayashi simply is not "made of one piece construction" as the Examiner contends (Office Action, page 3).

Furthermore, Kobayashi discloses a support member **10** that contacts a cathode bar **1** but *does not attach* to the cathode bar **1** in the manner as claimed. Specifically, in the claimed invention, the insulation portion of the single-piece device is attachable to the electrode for the express purpose of enabling physical transport of the electrode in and out of the electrolytic tank (*see e.g.*, Page 4, line 15-Page 5, line 13 of original specification). In contrast, the support member **10** of Kobayashi only contacts the cathode bar **1** as the support member **10** is moved laterally along the cathode bar rail **1**. Because Kobayashi does not teach a support member **10** that is attachable to the cathode bar **1**, Kobayashi fails to anticipate independent Claim 1 of the instant application.

In view of the arguments presented above, Applicants assert that the claimed invention is not anticipated by Kobayashi. Applicants respectfully request consideration and withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 1 and 2 as being anticipated by Kobayashi.

Response to Rejections under 35 U.S.C. §102(e)

Claims 1-3 have been rejected under 35 U.S.C. §102(e) as being anticipated by Wilson et al. (U.S. Patent 6,962,649, hereafter "the `649 patent"). According to the Examiner, the `649 patent discloses in Figures 6A, 6B, and 7 a cover of a dielectric sheath that has a bore

wherein the cover is a plastic sheath that encompasses a portion of a conductor so as to insulate the conductor and allow transfer of electrical current to a work piece (Office Action, page 4). Based on this teaching, the Examiner concludes that the `649 patent anticipates the claimed invention "because the dielectric sheath is of one piece construction and allows electrical conduction transfer through the conductor to the work piece and therefore is considered a transfer and insulation device because it does insulate the conductor and does transfer electrical current through the conductor to the work piece . . ." (Office Action, pages 4-5).

Applicants respectfully disagree with the Examiner's conclusions regarding the teaching of the `649 patent and assert that the `649 patent does not disclose each and every element of the claimed invention as applied to Claims 1-3. First, the Examiner's contention that the device taught by the `649 patent discloses the transfer portion element of the claimed device lacks any bases. As stated by the Examiner, the `649 patent teaches the "*transfer of electrical current* through the conductor" (Office Action, page 5, emphasis added). However, the transfer of electrical current simply is not the type of transfer that the transfer portion of the claimed device enables. The transfer portion of the claimed device is designed to be gripped by a transfer hook so as to enable the physical transport of an electrode in and out of the electrolytic tank (*see e.g.*, Page 4, line 15-Page 5, line 13 of original specification). Since no physical transfer of the device disclosed by the `649 patent even occurs, an argument simply cannot be made that the `649 patent teaches the transfer portion element of the claimed device. Additionally, because the `649 patent lacks a transfer portion element, it logically follows that the `649 patent does not disclose a single-piece device comprised of a transfer portion and an insulation portion. Moreover, the `649 patent does not disclose an insulation portion that is attachable to an electrode.

In view of the arguments presented above, Applicants assert that the claimed device is not anticipated by the '649 patent. Applicants respectfully request consideration and withdrawal of the 35 U.S.C. § 102(e) rejection of Claims 1-3 as being anticipated by Wilson et al.

Dependent Claims

Applicants have not independently addressed all of the rejections of dependent claims 2 and 3. Applicants submit that for at least similar reasons as to why independent claim 1 from which both dependent claims 2 and 3 depend are believed allowable as discussed *supra*, the dependent claims are also allowable. Applicants however, reserve the right to address any individual rejections of the dependent claims and present independent bases for allowance for the dependent claims should such be necessary or appropriate.

Thus, Applicants respectfully submit that the invention as recited in the claims as presented herein is allowable over the art of record, and respectfully request that the respective rejections and objections be withdrawn.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of this application. Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendment and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the

Examiner is invited to contact the undersigned at the number provided. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 4819-4714.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 4819-4714.

Respectfully submitted,
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